

REMARKS

It is requested that the time for responding to the outstanding Office Action be extended for three months, up to and including August 10, 2005. Please charge the \$510.00 extension fee and any additional fee required by this paper or credit any overpayment to Deposit Account No. 22-0261.

This paper responds to the Office Action dated February 10, 2005. In the Office Action the Examiner rejected claims 1-12 and 29-31 under 35 U.S.C. § 103 in view of Thatcher et al. and in view of Kelly.

1. The Thatcher Disclosure

Thatcher discloses a tournament system for games, including video games wherein a player can enter a tournament by inserting his or her credit card into a game terminal. According to the disclosure, each player is provided with a credit card and the game may be activated after activation of a "player identifier reader" at the game location. After the game event, the player's score is transmitted to a central computer. See Column 2, lines 58-59. The disclosure also includes a handicapping system wherein a player's score is modified by handicap values that may be stored by a central processor. Game applications disclosed by Thatcher include bowling tournaments (Column 1, lines 31-50) video games, pinball machines, and home computer games. Column 2, lines 11-22. Thus, the applicant recognizes that Thatcher provides a general disclosure of providing for tournaments over computer networks for "video games" including games played on home computers.

2. The Kelly Disclosure

The applicant further also acknowledges that Kelly disclose some of the claimed features of the present application. For instance, the Kelly reference generally discloses an electronic solitaire game wherein the player's score is based upon the speed of play, one of the features of the present invention. The applicant also agrees that Kelly discloses some of the other basic features of the underlying game such as the wild card feature.

The claimed invention is directed to an application of one of the particular systems that was broadly contemplated by Thatcher. In this regard, it is clear that Thatcher does not teach or disclose playing solitaire over his system nor does he disclose the specific game features that enable the applicant's solitaire game to be adapted for tournament play. The Examiner thereby combines Thatcher with Kelly to provide a teaching of an electronic solitaire game.

3. Argument

As explained herein, it submitted that (1) the specific game features that enable extended play are disclosed and claimed by the applicant are not rendered obvious by Thatcher and Kelly and (2) the claimed new tournament concepts are entirely absent from Thatcher and Kelly. It is submitted that while Kelly discloses some of the features, the Kelly does not teach the applicant's invention--nor does it lead one skilled in the art in the path of the applicant's invention.

An important feature of Kelly's invention is the concept of using an equalized deck or seeded deck to ensure that a predetermined minimum number of moves are possible during a

particular game. See Column 10, lines 32 et seq. See also column 15, lines 26-33. The seeded deck feature is important to Kelly because (1) it increases the skill element of the game and (2) it results in fewer instances when a player becomes stuck early in a game. Kelly also discloses the concept of using wild cards that are interspersed in the deck to equalize the decks. See column 11, lines 7-15.

It is submitted that claim 1 is not obvious over Thatcher in view of Kelly because Kelly does not disclose or suggest providing the recited “*game rules and game patterns to extend play.*” Rather, Kelly’s manner in which to extend play of the game or diminish the effects of “short stacks” is to provide equalized decks or intersperse wild cards within a deck to achieve an equalized deck. In addition to this distinguishing feature, the requirement in claim 1 that the card sequence be *random* also distinguishes over the Kelly reference. Kelly uses “equalized decks” which are thereby not random sequences but rather reflects preselected sequences.

Kelly’s use of a seeded deck feature is significant in the context of the Applicant’s invention because applicant also addressed these same problems—the problem relating to increasing the level of skill exercised by players in the game and ensuring the length of the games is appropriate—and solved them in a different way. While Kelly used a seeded deck, the Applicant provided alternative solutions including the various claimed game features which serve to extend play. These features as set forth in the dependent claims include, *inter alia*,

- (1) the play later feature (see claims 9 and 23),
- (2) the multi-game tournament features wherein the skill of a player is measured over an

interval of multiple game events rather than a single game, such as the sprint game (see claim 14) and “bust the deck” game (see claim 16),

(3) the multiple discard play stack features (see claims 6 and 20), and

(4) the wild card feature (see claims 8 and 22)¹. The inventors also developed additional game features including the target bonus feature that makes the game more fun to play, see claims 1 and 21, and devised tournament entry criteria to make play fair or more competitive. See claim 17. It is submitted that none of these game concepts are taught or suggested by the prior art. While the Examiner suggests that the multiple discards stacks are commonly employed in Klondike Solitaire, the applicant is not aware of such prior art. Further, to the extent such a disclosure may be found, it is submitted that its application in the present game is not an obvious extension absent the teachings of the present invention. In connection with the Examiner’s position with respect to the rejection of claim 9, the Examiner contends that it would have been obvious to employ the multiple play stacks that are present in other games to the claimed Klondike solitaire. The applicant also disagrees. There are a very large number of solitaire and other card games and the number of potential game patterns or rules are immense. These rules and patterns are developed to be compatible with the particular game and cannot be freely

¹ The Applicant understands that a wild card feature was disclosed by Kelly. However the wild card concept disclosed by Kelly is different than the concept disclosed and claimed by the applicant. In Kelly’s game wild cards are dispersed throughout the play decks and the player does not use strategy when playing a wild card. See Kelly at column 11, lines 6-115. In contrast, in the applicant’s game, the wild card may be played at any time and the player must make a decision as to when it may be advantageous to play the card.

interchanged without materially affecting the game play, game strategy and the object of the game.

In response to the Examiner's rejection of claims 9 and 23, the "future play" feature that is discussed by Kelly is not applicable to the Klondike version of solitaire but rather relates to a different solitaire game identified as "elevens." See Kelly, columns 15 and 16. The applicant therefore disagrees that this disclosure either anticipates or renders obvious the "future play" feature as claimed. It is noteworthy that Kelly limited his discussion of a future play option to the "elevens" game where the concept may have been a part of the conventional rule paradigm.

In connection with the target bonus feature recited in claims 7 and 21, the applicant agrees that Kelly contemplates awarding a bonus for the execution of certain card moves. While Kelly does not specifically disclose a target feature for clearing a column, the applicant appreciates that this feature may be considered obvious in view of the foregoing general disclosure and therefore, does not rely upon this recited feature for patentability.

In connection with claim 12, the applicant also agrees that Kelly discloses an end game feature and the applicant does not rely upon this concept for patentability.

In connection with the rejection of claim 14 (the Sprint Game), the Examiner takes the position that the game ending event feature is not critical. It is the Applicant's position that this alteration of conventional solitaire by creating a unique tournament structure enables a solitaire game that was not amenable for tournament play to one that is appropriate for tournament play. This feature also diminishes the adverse effect of short stacks. This feature is not merely a

design choice but is an alternative method to extend play--one of the articulated central objects of the present invention.

In connection with the rejection of claim 13, the applicant bases his position on patentability with the features recited in the independent claim 12. With respect to the Examiner's application of the Spaur et al. U.S. Patent No. 6,196,920 ("Spaur") to claims 13, 15-28, by the present amendment, the applicant has limited the invention to a Klondike-style solitaire game. Spaur's invention is directed to on-line multiplayer games where multiple players play on a single play field in real time and an advertising feature. The applicant's claimed game distinguishes from Spaur, *inter alia*, because multiple players do not play on the same play field at the same time on a shared screen with the same data input. Klondike-style solitaire is a one-player game. In contrast, Spaur's game contemplates head to head competition using a single input dictating the card sequence. In contrast, in the applicant's game format, games are played on separate screens having separate and independent input relating to the card sequence. One advantage disclosed by the claimed invention is that players do not have to wait for others in order to begin play. In addition, some players prefer to play against the clock or computer rather than directly compete with others players. Finally, the claimed structure enables intermittent communication with the server which allows play on almost any bandwidth. In view of the speed scoring features, real time play would not be compatible with the applicant's invention.

To the extent that the Examiner relies upon Kelly as a basis to reject the claimed communication features recited in claim 1, the applicant disagrees with the Examiner. The

communication features in Kelly are incorporated for different reasons than the reasons the applicant has linked his game. In this regard, a central feature of Kelly's game is the progressive bonus wherein a jackpot or bonus score is stored until a predetermined criteria has been met. The progressive bonus taught by Kelly may be set to increase based upon input from a single machine or a multiple number of machines that have been linked together. See Kelly, column 6, line 62 through column 7 line 23. Linking to numerous games increases the potential bonus and avoids a situation where there is no incentive to play games at the same premises having a lower bonus. It is therefore submitted that Kelly's "linking" feature is for a different purpose from that disclosed and claimed by the applicant. A further purpose of the communication link disclosed by Kelly was to *facilitate the redemption features*. See column 6, lines 53-61. Yet a third reason to link games is to allow multi-player games involving the simultaneous play of a card game on a single play field. See Kelly, column 7, lines 23-42. See also column 9, lines 1-3, column 6, lines 53-61. It is submitted that the linking feature of Kelly is not related to providing a tournament format and therefore, the Kelly reference does not disclose or suggest playing solitaire in the claimed tournament format. There is no motivation or suggestion in the Kelly reference to arrange for play in a tournament format.

While Kelly's communication is not relevant, the applicant agrees that Thatcher provides adequate disclosure to generally suggest providing communications structures or communications links in order to allow tournament play to function. However, neither Thatcher nor Kelly teaches or suggests transmitting data relating to the sequence of play of the game after

the play of the game has been completed in response to the server recognizing that a winning score has been posted. See claim 1. The prior art merely discloses transmitting the identity of the player and the respective scores. As explained in the specification, this claimed feature minimizes the opportunity for fraud on the system. See specification at pages 16-17.

Accordingly, claim 1 is further allowable in view of this limitation.

I. There is no motivation to combine Thatcher with Kelly

The Examiner's rejection is first based upon the tournament concept that is taught by the Thatcher reference. The Applicant respectfully disagrees that one skilled in the art would be motivated to combine Thatcher and Kelly to reach the claimed invention. First, the Thatcher reference itself does not suggest its tournament concept would be applicable to electronic card games. Thatcher's system generically discloses a system for linking conventional "various kinds of video games, microprocessor operated pinball games, home computer video games, or the like. " See column 2, lines 11-15. The inventors specifically identify PACMAN TM and SARGON TM. See column 12, lines 44-47. At column 11, lines 24-28 the inventors discuss the number of tries or number of men that are used during the game.

One of the reasons that Thatcher may have not considered card games, and more particularly solitaire, is because tournament play for electronic solitaire card games is counter-intuitive. Conventional solitaire, as reflected and reinforced by its very nomenclature, is intended to be played alone. Because solitaire is played alone and there is not a conventional scoring methodology, one skilled in the art would not consider solitaire as an appropriate game to adapt

to a tournament structure. While there are numerous electronic solitaire games available, on information and belief, the overwhelming majority of these games are designed for single players. One of the reasons that it is not obvious to adapt solitaire to tournament formats is because the play of solitaire in most formats is not subject to numerical scoring. Games in conventional formats are either won, by busting the deck, or lost when a player becomes “stuck.” Yet a further obstacle that would discourage those skilled in the art from selecting solitaire is that the end results are often the result of chance or luck rather than the exercise of skill. For example, it has been estimated that the chances of busting the deck using conventional solitaire rules in the Klondike version are approximately 1 in 30. See Exhibit 1. In conventional solitaire formats and rule paradigms, the games would frequently end after a few iterations of play because the player could not make a valid move and therefore would become stuck. Such games, referred to as “short stacks” are unsatisfactory to the player.

In addition, unlike golf games or tennis games or even bridge, solitaire is not conventionally played in a tournament format. The applicant rejects the notion that the Thatcher suggests that *all* video games may be adapted to a tournament structure. For example, many video games or personal computer games simply do not involve a competitive play concept and other games do not have appropriate scoring structures.

While there were a variety of reasons why electronic solitaire was not readily appropriate for adaptation to competitive tournament play, the inventors recognized that, if the problems identified above could be overcome, the game could be a success. The inventors thought the

game may be appropriate for tournament play because the game concept is widely recognized and it is easily understood.

While Kelly recognized some of the problems with making a successful video game from the solitaire concept, he did not consider its applicability for tournament play. Like the applicant, Kelly devised a game wherein the score was based upon the speed of play. However, Kelly's response to the short stack problem--providing seeded decks that contained a predetermined minimum number of possible moves--was different than the inventor's solution. It is therefore submitted that one skilled in the art would not have been motivated to combine Thatcher with Kelly to provide the claimed solitaire tournament game. It is only with the hindsight of the inventor's success, using the blueprint of the applicant's invention, that the combination of Thatcher and Kelly makes sense.

II. The combination of Thatcher and Kelly does not teach the invention as claimed.

Even if one were to combine the Kelly solitaire game with the Thatcher tournament concepts and adapt Kelly's solitaire game to a tournament format, it is submitted that this combination does not result in the claimed invention. First of all, as discussed above, Kelly's game uses a seeded deck rather than the random sequence of cards that is provided by the server combined with the extended play game rules and game patterns as recited in claim 1. In addition, Kelly does not disclose or suggest:

- (a) the future play feature (see claims 9 and 23)

(b) the multiple play stacks feature (see claims 6 and 20)

(c) Playing in a tournament structure that allows for multiple game events or iterations of new decks that are dealt and distributed. By providing the player with an increased number of play decks or games within a particular tournament, the adverse affect of receiving a short stack is diminished. See claim 14 (Sprint game feature) and claim 16 ("bust the deck" feature).

These innovative and creative concepts were developed by the applicant and applied to the solitaire game subject of the patent application. It is submitted that they are neither anticipated nor are these concepts obvious and therefore the applicant merits patent protection for the invention.

III. Objective indicia suggest that the claimed invention is not obvious

In addition to the reasons set forth above, the applicant requests that the Examiner consider the following objective evidence that tends to show that the invention is not obvious in view of the cited prior art.

A. Commercial Success

The tournament solitaire game that is the subject of the present application has been commercialized by Tournament Games, Inc. and is marketed as Tournament Solitaire 2000. It is available for download and play on the internet site identified as www.tournamentgames.com.

Notwithstanding the crowded and competitive market of internet games that Tournament Games operates within, the solitaire tournament game and format has been a resounding success and, it

is submitted, the claimed features of the game are an important part of this success.

As reflected by the declaration of Mr. Jack Pearson submitted herewith, the software development costs for the Tournament Game system were approximately \$200,000 which primarily reflects the salary paid to employees and consultants for programming efforts. Tournament Solitaire 2000, a commercial embodiment of the claimed new features, was launched in 2000. As Mr. Pearson's declaration reflects, the game generated revenues of almost \$1.5 million dollars and profits of over \$300,000 by 2004.

Notwithstanding (1) the limited advertising and marketing of the game, (2) the crowded marketplace for on-line games and (3) the proliferation of free internet games, this small Tennessee-based company has consistently earned a profit since its inception. This fact is remarkable considering the fact that it competes against heavily capitalized companies that have significant advertisement budgets and the ability to steer internet users to their respective sites. Popular websites such as Google, Yahoo and Microsoft Network, on information and belief, provide competing games for free and, on information and belief, operate on a business model wherein revenue is earned through advertising.

Despite the limited marketing budget, the number of subscribers to the Tournament Games site continues to grow, the number of games played continues to increase and the revenues from game play continues to increase. *Id.* On information and belief, one of the major driving forces of the growth is based upon recommendations by existing players. While Tournament Game's Internet site has a number of games available, the claimed Tournament

Solitaire 2000 game remains the most popular choice and it is believed that the popularity of the game is directly attributed to the claimed features. See Declaration of Mr. Pearson.

It is submitted that in these circumstances the commercial success of the invention is particularly probative of the obvious inquiry. Notwithstanding the teachings of Thatcher, Kelly and others, there existed an untapped market for an appropriate solitaire game prior to the inventor's development. As the declaration of Jack Pearson shows, there was an economic incentive to make games like Tournament Solitaire 2000 because it would be easily understood by most players and therefore be user friendly. From an economic standpoint, developing the game and providing and managing the on-line tournament structure have relatively low entry barriers. Yet without the foresight of the inventors, this market may have been left undeveloped. Had the game been obvious, others would have quickly reaped the financial rewards and the present day market would be saturated with competing games.

B. Teaching Away

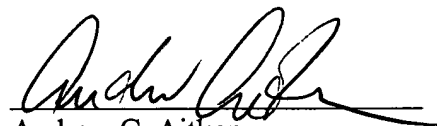
While the Examiner relies upon the Kelly patent in the Office Action, in actuality it teaches away from the present invention. The Kelly patent would tend to lead one skilled in the art to alternative directions than those the inventors pursued and claimed in the patent. If one followed the teachings of Kelly, the resulting product would have incorporated an equalized deck concept, and not the various play features that were developed and claimed. In addition, while Kelly understood and appreciated some of the problems with adapting the solitaire game concept to an electronic version, he failed to appreciate that the game could be significantly enhanced by

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being played in a structured tournament format. Rather, Kelly disclosed simply posting the scores in a convention 'High Game' or 'High Score' arrangement rather than injecting a competitive tournament concept.

Wherefore, it is submitted that the invention as claimed is novel and constitutes an unobvious and patentable improvement over the prior art. In view of the foregoing, the applicant respectfully requests that the Examiner issue a Notice of Allowance.

Respectfully submitted,



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